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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
09/997,269	11/27/2001	Jeffry J. Grainger	021737-000720US	2593
20350 7590 02/03/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER DARNO, PATRICK A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/997,269

Applicant(s)

GRAINGER, JEFFRY J.

Examiner

PATRICK A. DARNO

Art Unit

2169

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 06262006.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 34-43 are new. Claims 8, 16, 18, 24, and 31 are amended. Claims 1-43 are pending in this office action.

Information Disclosure Statement

2. The information disclosure statement received 06/26/2006 has been considered. The information disclosure statement filed 03/06/2003 could not be located by the Examiner. If the Applicant desires to have this information disclosure statement considered it will need to be re-submitted. If the Applicant has any questions regarding this issue, he/she can contact the Examiner using the contact information listed below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-15 and 34-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,549,894 issued to Robert P. Simpson et al. (hereinafter "Simpson") in view of U.S. Patent Number 5,991,751 issued to Kevin G. Rivette et al. (hereinafter "Rivette") and further in view of U.S. Patent Number 5,107,419 issued to Margaret G. MacPhail (hereinafter "MacPhail").

Claim 1:

Simpson discloses a computer-implemented method of managing documents related to a patent application (*Simpson: abstract and column 1, lines 45-54*), said method comprising:

Art Unit: 2169

storing a plurality electronic documents related to a patent application in a database accessible to a server system, wherein each of said plurality of electronic documents has a document type and wherein said plurality of stored documents includes at least one document having a first document type and at least one document having a second document type (*Simpson: column 2, lines 1-55 and column 4, lines 34-67*);

receiving a signal at said server system indicating said predetermined event has occurred; (*Simpson: column 3, lines 4-45 and column 6, lines 30-45*).

Simpson fails to expressly disclose storing a plurality of electronic documents related to a patent application in a database accessible to a server system. It would have been obvious to one having ordinary skill in the art at the time the invention was made to store a plurality electronic documents related to a patent application in a database accessible to a server system since storing data in a database for access by a server would enable the data to be stored remotely and be accessed by several users. Furthermore, storing data in a database is well-known, regardless of the type of data. While storing data related to a patent application is just deemed to be a form of data, Examiner addresses this none-the-less and states that storing patent application data in a database was well know in the art at the time the invention was made and that storing such information is deemed helpful to a user writing or tracking the status of a patent application so that the data can be retrieved when needed since deadlines and filings are dictated by statutes.

Furthermore, Rivette discloses storing a plurality of electronic documents related to patent applications in a database accessible to a server system (*Rivette: abstract and column 10, lines 8-16 and column 13, lines 35-44 and column 17, lines 11-39 and column 56-67 and column 59, lines 23-41*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to

Art Unit: 2169

modify the teachings of Simpson with the teachings of Rivette noted above. The skilled artisan would have been motivated to improve the teachings of Simpson per the above in order to aid a corporate entity in developing business-related strategies, plans, and actions (*Rivette: column 10, lines 4-7*).

The combination of Simpson and Rivette fails to expressly disclose storing a rule in said database that indicates specific document types to be deleted from said database in response to a predetermined event occurring related to a document, wherein said rule indicates that documents of said second type should be deleted but not documents of said first type.

However, MacPhail teaches that it is known to store a rule in said database that indicates specific document types to be deleted from said database in response to a predetermined event occurring related to a document, wherein said rule indicates that documents of said second type should be deleted but not documents of said first type (*MacPhail: column 1, lines 55-67 and column 2, lines 1-4*).

after receiving said signal, implementing said rule to delete documents of said second type in said database that are related to said patent application but not delete documents of said first type that are related to said patent application (*MacPhail: abstract and column 1, lines 22-44 and column 1, lines 59-67 and column 2, lines 1-55*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of MacPhail noted above. The skilled artisan would have been motivated to improve the previously mentioned combination per the above in order to free up storage space in a computer system by deleting

Art Unit: 2169

selected documents that are no longer needed from the computer system as soon as possible

(MacPhail: column 1, lines 55-67 and column 2, lines 1-3).

Claims 2, 12, and 13:

The combination of Simpson, Rivette, and MacPhail discloses all the elements of claim 1, and Simpson further discloses wherein said predetermined event is either grant of a patent from said patent application or payment of an issue fee for said patent *(Simpson: column 3, lines 4-45 and column 7, lines 24-26 and Fig. 5A; See "Notice of Allowance" in Fig. 5A. Also note notifying a user of due dates for "fees to be paid" [Simpson: column 3, lines 5-10].)*

Claim 3:

The combination of Simpson, Rivette, and MacPhail discloses all the elements of claim 1, as noted above, and Simpson further discloses wherein said predetermined event is a signal received from an authorized client system *(Simpson: column 5, lines 35-48).*

Claim 4:

The combination of Simpson, Rivette, and MacPhail discloses all the elements of claim 1, as noted above, and Simpson further discloses wherein said first document type is a filed patent application and wherein said second document type is a draft patent application *(Simpson: column 1, lines 65-67 and column 2, lines 1-36 and column 4, lines 45-67).*

Claims 5 and 14:

The combination of Simpson, Rivette, and MacPhail discloses all the elements of claim 1, as noted above, and Simpson further discloses wherein said patent application is assigned to a first technology developer and wherein said signal is generated by a client system associated

Art Unit: 2169

with said first technology developer (*Simpson: column 4, lines 1-67 and column 5, lines 5-67 and column 6, lines 1-45*).

Claim 6:

The combination of Simpson, Rivette, and MacPhail discloses all the elements of claim 5, as noted above, and Simpson further discloses wherein said client system is associated with a patent practitioner that represents said first technology developer (*Simpson: column 4, lines 1-67*).

Claims 7 and 15:

The combination of Simpson, Rivette, and MacPhail discloses all the elements of claim 1, as noted above, and Simpson further discloses wherein said executing step is in response to receipt of said signal (*Simpson: column 4, lines 1-67 and column 5, lines 5-67 and column 6, lines 1-45*).

Claim 8:

The combination of Simpson, Rivette, and MacPhail discloses all the elements of claim 1, as noted above, and Simpson further disclose wherein said plurality of electronic documents also includes at least one document having a third document type, said third document type being associated with unofficial notes from an inventor of said patent application to a practitioner, and wherein said rule causes said server to delete documents of said third type associated with said patent application during said executing step (*Simpson: column 1, lines 65-67 and column 2, lines 1-36 and column 4, lines 45-67*).

Claim 9:

The combination of Simpson, Rivette, and MacPhail discloses all the elements of claim 1, as noted above, and Simpson further discloses wherein said plurality of electronic documents also includes at least one document having a fourth document type, said fourth document type

Art Unit: 2169

being associated with versions of patent papers stored in said database in an image file format that were generated by a patent office, and wherein said rule does not cause said server to delete documents of said fourth type associated with said patent application during said executing step
(Claim 9 is rejected under the same reasons set forth in the rejection of claim 1, and further in view of Simpson:

column 1, lines 65-67 and column 2, lines 1-36 and column 4, lines 45-67).

Claim 10:

The combination of Simpson, Rivette, and MacPhail discloses all the elements of claim 1, and MacPhail further discloses allowing a client system to create and/or modify said rule that defines specific document types to be deleted and/or specific types of documents to be saved in response to receiving said signal (*MacPhail: abstract and column 1, lines 22-44 and column 1, lines 55-67 and column 2, lines 1-55).*

Claim 11:

Claim 11 is rejected under the same reasons set forth in the rejection of claim 1.

Claims 34, 37, and 41:

The combination of Simpson, Rivette, and MacPhail discloses all the elements of claim 1, as noted above, and Rivette further discloses wherein the plurality of documents comprises word-processed document files, form-based document files and image files (*Rivette: column 17, lines 11-40; Note especially, column 17, lines 37-40).*

Claims 35, 38, and 42:

The combination of Simpson, Rivette, and MacPhail discloses all the elements of claim 34, as noted above, and Rivette further discloses wherein each electronic document in the

Art Unit: 2169

plurality of documents has document meta data associated with the document that identifies the document (*Rivette: column 17, line 49 – column 18, line 2*).

Claims 36, 39, and 43:

The combination of Simpson, Rivette, and MacPhail discloses all the elements of claim 35, as noted above, and Rivette further discloses wherein the document meta data further identifies the history of each document (*Rivette: column 17, line 49 – column 18, line 2; Note specifically that the metadata includes "fields of search, references cited, primary examiner, assistant examiner, and the attorney, agent, or law firm" involved in the prosecution history of the case.*).

Claim 40:

Claim 40 is rejected under the same reasons set forth in the rejection of claims 1 and 11.

4. Claims 16-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,991,751 issued to Kevin G. Rivette et al. (hereinafter "Rivette") in view of U.S. Patent Number 6,549,894 issued to Robert P. Simpson et al. (hereinafter "Simpson") and further in view of U.S. Patent Number 5,107,419 issued to Margaret G. MacPhail (hereinafter "MacPhail").

Claim 16:

Rivette discloses a server system for managing information related to patent applications (*Rivette: see at least 25-44 and Fig. 3*), said server system comprising:

- (a) a processor (*Rivette: column 14, lines 18-30*);
- (b) a database (*Rivette: column 13, lines 25-34*); and
- (c) a memory for storing a program (*Rivette: column 14, lines 30-33*);

Art Unit: 2169

wherein said processor is operative with said program to:

(i) store, in said database, a plurality of electronic documents related to a patent application, said electronic documents including at least an invention disclosure, a patent application as filed in an official patent office, unofficial documents related to said patent application and one or more papers generated by said official patent office that are related to said patent application (*Rivette: abstract and column 10, lines 8-16 and column 13, lines 35-44 and column 17, lines 11-39 and column 56-67 and column 59, lines 23-41*).

Rivette fails to expressly disclose in response to an indication from said official patent office that said patent application has been allowed, receiving an instruction to categorize the patent as allowed in the database. However, Simpson discloses in response to an indication from said official patent office that said patent application has been allowed, receiving an instruction to categorize the patent as allowed in the database (*Simpson: column 3, lines 4-45 and Fig. 5A; See "Notice of Allowance" in Fig. 5A. Also note notifying a user of due dates for "fees to be paid" [Simpson: column 3, lines 5-10].*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Rivette with the teachings of Simpson noted above. The Skilled artisan would have been motivated to improve the teachings of Rivette per the above such that by maintaining a docketing system of legal matters, and information related to legal matters user of the system is presented with the advantage of being alerted by the system when a specific legal matter arises which requires the user's attention (*Simpson: see at least the abstract*).

The combination of Rivette and Simpson fails to expressly disclose:

Art Unit: 2169

automatically deleting said unofficial documents related to said patent application from said database.

However, MacPhail discloses that it is known in the art to store a rule in a database that indicates a specific document type to be deleted from said database in response to a predetermined event occurring related to a document, wherein said rule indicates that documents of said section type should be deleted but not documents of said first type (*MacPhail: column 1, lines 55-67 and column 2, lines 1-4*), and;

after receiving a signal, implementing said rule to delete documents of said second type in said database that are related to said patent application but not delete documents of said first type that are related to said patent application (*MacPhail: abstract and column 1, lines 22-44 and column 1, lines 59-67 and column 2, lines 1-55*).

As a result of the above teachings of MacPhail, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the previously mentioned combination with the teachings of MacPhail noted above. The skilled artisan would have been motivated to improve the previously mentioned combination per the above in order to free up storage space in a computer system by deleting documents that are no longer needed from the computer system as soon as possible (*MacPhail: column 1, lines 55-67 and column 2, lines 1-3*).

Claim 17:

The combination of Rivette, Simpson, and MacPhail discloses all the elements of claim 16, as noted above, and MacPhail further discloses wherein said processor is operative with said program to allow a client system to set-up workflow rules related to defining specific types of

Art Unit: 2169

documents to be deleted and/or specific types of documents to be saved in response to receiving an instruction that a patent application has been allowed (*MacPhail: : abstract and column 1, lines 22-44 and column 1, lines 55-67 and column 2, lines 1-55*).

Claim 18:

The combination of Rivette, Simpson, and MacPhail discloses all the elements of claim 16, as noted above, and Rivette further discloses wherein said unofficial documents include one or more of: notes from an inventor of said patent application to a practitioner (*Rivette: column 16, lines 18-67; Note specifically R&D information and the like. Such information would be notes from an inventor. And these notes are maintained in the patent database which is accessible by patent practitioners.*), draft copies of said patent application and draft copies of Responses to Office Actions.

Claim 19:

Claim 19 is rejected under the same reasons set forth in the rejection of claim 16.

Claim 20:

The combination of Rivette, Simpson, and MacPhail discloses all the elements of claim 19, as noted above, and Rivette further discloses wherein the plurality of electronic documents are stored in a database that is accessed through a database management system (*Rivette: column 23, line 57 – column 24, line 51*). .

Claim 21:

The combination of Rivette, Simpson, and MacPhail discloses all the elements of claim 20, as noted above, and Rivette further discloses wherein each document in the plurality of

Art Unit: 2169

electronic documents has an attribute associated with it that identifies the document as belonging to either the first plurality of electronic documents or the second plurality of electronic documents (*Rivette: column 11, lines 20-35 and column 12, lines 31-34; Note that at least two types of groups are identified: 1) groups of patents, and 2) groups of non-patent documents. Furthermore, note that each group can be "identified." Therefore, there must be some form of identifier that permits the computer system to identify each group.*).

Claim 22:

The combination of Rivette, Simpson, and MacPhail discloses all the elements of claim 21, as noted above, and MacPhail further discloses storing a rule in the database that generates the request to delete the second plurality of documents in response to the occurrence of a predetermined event (*MacPhail: abstract and column 1, lines 22-44 and column 1, lines 55-67 and column 2, lines 1-55*).

Claim 23:

The combination of Rivette, Simpson, and MacPhail discloses all the elements of claim 22, as noted above, and Simpson further discloses wherein the predetermined event is on of: payment of an issue fee for a patent application or granting of a patent from the patent application (*Simpson: column 3, lines 4-45 and column 7, lines 24-26 and Fig. 5A; See "Notice of Allowance" in Fig. 5A. Also note notifying a user of due dates for "fees to be paid" [Simpson: column 3, lines 5-10].*).

Claim 24:

The combination of Rivette, Simpson, and MacPhail discloses all the elements of claim 23, as noted above, and Simpson further discloses wherein the granting of a patent from the patent application is identified by either a signal sent from an authorized client system (*Simpson:*

Art Unit: 2169

column 5, lines 35-48 and column 3, lines 4-45 and Fig. 5A; See "Notice of Allowance" in Fig. 5A. Also note notifying a user of due dates for "fees to be paid" [Simpson: column 3, lines 5-10].) or association of an image file of the granted patent with the patent application.

Claim 25:

The combination of Rivette, Simpson, and MacPhail discloses all the elements of claim 20, as noted above, and MacPhail further discloses wherein each of the plurality of electronic documents has a document type associated with it; wherein the method further comprises storing a rule in the database that identifies the first and second pluralities of electronic documents based on each document's document type in response to a predetermined event (*MacPhail: column 1, lines 55-67 and column 2, lines 1-4*); and wherein the request is generated after execution of the rule (*MacPhail: abstract and column 1, lines 22-44 and column 1, lines 59-67 and column 2, lines 1-55*).

Claim 26:

The combination of Rivette, Simpson, and MacPhail discloses all the elements of claim 19, as noted above, and Simpson further discloses wherein the request is generated by a user (*Simpson: column 4, lines 1-67 and column 5, lines 5-67 and column 6, lines 1-45*).

Claim 27:

Claim 27 is rejected under the same reasons set forth in the rejection of claim 16.

Claim 28:

Claim 28 is rejected under the same reasons set forth in the rejection of claim 21.

Claim 29:

Claim 29 is rejected under the same reasons set forth in the rejection of claim 22.

Art Unit: 2169

Claim 30:

Claim 30 is rejected under the same reasons set forth in the rejection of claim 23.

Claim 31:

Claim 31 is rejected under the same reasons set forth in the rejection of claim 24.

Claim 32:

Claim 32 is rejected under the same reasons set forth in the rejection of claim 25.

Claim 33:

Claim 33 is rejected under the same reasons set forth in the rejection of claim 26.

Response to Arguments

Argument #1:

Applicant Argues:

Applicants have carefully reviewed Cronin and respectfully assert that Cronin does not teach a plurality of electronic documents related to a patent application in a database.

Examiner Responds:

Examiner is persuaded. As a result, the Cronin reference is no longer being applied as part of the prior art rejections. The Rivette patent has replaced the Cronin reference as part of the rejections under 35 U.S.C. 103(a). Rivette clearly teaches storing intellectual property information in the form of electronic documents [Rivette: abstract and column 10, lines 8-16 and column 13, lines 35-44 and column 17, lines 11-39 and column 56-67 and column 59, lines 23-41]. Therefore, the Applicant's arguments set forth above are rendered moot.

Art Unit: 2169

Since it appears that each and every element of the Applicant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reason set forth in the preceding office action.

Argument #2:

Applicant Argues:

Moreover, even assuming *arguendo* that Cronin teaches storing electronic documents, there is no disclosure or suggestion in Cronin that some documents have a first document type while other documents have a second document type as recited in claim 1.

Examiner Responds:

Examiner is persuaded. As a result, the Cronin reference is no longer being applied as part of the prior art rejections. The Rivette patent has replaced the Cronin reference as part of the rejections under 35 U.S.C. 103(a). Rivette clearly discloses documents of a first type and documents of a second type [see at least Rivette: column 10, lines 8-23]. Therefore, the Applicant's arguments set forth above are rendered moot.

Since it appears that each and every element of the Applicant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reason set forth in the preceding office action.

Argument #3:

Applicant Argues:

Applicants also respectfully assert that deficiency (1) is not obvious to a person of ordinary skill in the art based upon the Simpson reference alone.

Art Unit: 2169

Applicants remind the Examiner that claim 1 recites storing a plurality of electronic documents, not just "storing patent application" as this paragraph of the Rejection suggests, and that such stored electronic documents include at least some documents having a first document type and other documents having a second document type. If this aspect of the invention is as well known as the Examiner believes it to be, Applicant's respectfully request that the Examiner provide a reference to that affect.

Examiner Responds:

Examiner is persuaded. As a result, the Cronin reference is no longer being applied as part of the prior art rejections. The Rivette patent has replaced the Cronin reference as part of the rejections under 35 U.S.C. 103(a). Rivette clearly teaches storing intellectual property information in the form of electronic documents [Rivette: abstract and column 10, lines 8-16 and column 13, lines 35-44 and column 17, lines 11-39 and column 56-67 and column 59, lines 23-41]. Therefore, the Applicant's arguments set forth above are rendered moot.

Since it appears that each and every element of the Applicant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reason set forth in the preceding office action.

Argument #4:**Applicant Argues:**

With respect to deficiency (2), the Examiner states that "MacPhail teaches that it is known to store a rule in said database that indicates specific document types to be deleted from said database in response to a predetermined event occurring related to a document, wherein said rule indicates that documents of said second type should be deleted but not documents of said first type." Office Action, page 4. No specific reference is made to any part of the MacPhail patent, however, for this teaching.

Examiner Responds:

Examiner is not persuaded. MacPhail discloses at least two rules which indicate specific document types to be deleted from said database in response to an event occurring related to a document [see at least MacPhail: column 1, lines 55-67]. First, MacPhail discloses at least two types of

Art Unit: 2169

documents: Documents which are needed, and Documents which are not needed. Second, MacPhail discloses rule 1) which deletes documents which are no longer needed by the system as soon as possible, and rule 2) that a document should be maintained as long as it is needed by the document owner of the enterprise.

Since it appears that each and every element of the Applicant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Argument #5:

Applicant Argues:

As stated in the last Response, Applicants have reviewed the MacPhail reference in detail and respectfully assert that MacPhail does not teach "storing a rule that indicates specific document types to be deleted" as recited in Claim 1.

The only rules disclosed by MacPhail are rules that calculate the expiration date as discussed with respect to Figs. 12a, 12b, and 13a-13d. See col. 10, lines 1-41. Such rules do not delete documents based on a document type associated with the document as required by claim 1.

Examiner Responds:

Examiner is not persuaded. As noted above, MacPhail discloses at least two groups of documents: Documents which are needed, and Documents which are not needed [MacPhail: column 1, lines 55-67]. As this passage shows, there are at least two rules/criteria for determining when a document is no longer needed. When it is determined that documents are of the "type" not needed, the documents are deleted. Therefore, it appears to be clear that MacPhail discloses deleting documents based on a document type associated with a document, as required by claim 1.

Since it appears that each and every element of the Applicant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Argument #6:

Applicant Argues:

Applicants further assert that the rejection of each of the dependent claims is deficient. 37 C.F.R. §1.104(c)(2) states that the pertinence of each reference must be clearly explained when rejecting a claim. See also MPEP 707 and 707.05 (when prior art is cited its pertinence should be explained).

Examiner Responds:

Examiner is not persuaded. The comments set forth by the Applicant, and reproduced above, fail to adequately set forth reasons as to why the Applicant's claimed invention is patentably distinct from the cited prior art. Furthermore, the comments set forth above do nothing to move the current application for patent closer to allowance.

The Examiner's statement of rejection comprises reproducing the Applicant's claims and citing a limited, relatively specific portion of the references where the Examiner asserts that the limitations of the Applicant's claim are disclosed. By giving such relatively specific portions of the prior art which are relevant, the Examiner has clearly satisfied the requirements of 37 C.F.R. 1.104(c).

The Examiner notes that a further explanation of the cited prior art is only needed if it is not readily apparent why the reference is relevant to a given claim limitation [37 C.F.R. 104(c)(2)].

After a further review of the statement of rejection given, the Examiner remains convinced that it is readily apparent to one of ordinary skill in the art as to why the cited portions of the prior art are presented as disclosing the Applicant's claimed invention.

And finally, it is noted that even if any portion of the Examiner's office action is still found to be unclear, the Examiner is made directly accessible to the Applicant by way of a personal interview. In the event that there are portions of an office action that appear unclear, it is best that the Applicant set up an interview with the Examiner to discuss and clear up any ambiguities.

Because the arguments above fail to set forth any reason why the prior art fails to disclose any aspect of the Applicant's claimed invention, the claims remain rejected under 35 U.S.C. 103(a).

Argument #7:

Applicant Argues:

Claim 11 also recites a number of other elements not recited in claim 1 including, for example, that each of the stored electronic documents has an attribute associated with it and that a rule is stored that deletes documents based on the value of this attribute.

Examiner Responds:

Examiner is not persuaded. Both Rivette and MacPhail disclose where attributes are associated with a document [Rivette: column 17, line 49 – column 18, line 55; See Bibliographic Database.] [MacPhail: see Figs. 8-13d]. Furthermore, MacPhail discloses deleting the documents based upon the value of these attributes [MacPhail: see at least the abstract].

Art Unit: 2169

Since it appears that each and every element of the Applicant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Argument #8:

Applicant Argues:

Claim 16 is an apparatus claim that requires a processor, a database and a program stored in a memory that operates to store an invention disclosure, a patent application and unofficial documents related to the patent application in the database. As discussed above, Simpson does not disclose such an apparatus.

Examiner Responds:

Examiner is persuaded. As a result of the persuasive argument set forth by the Applicant, the prior art used in the rejection of the claims has been modified. The new reference introduced is the Rivette reference. Rivette discloses the apparatus described above, and this is evident by the rejection of claim 16 given above. The mapping of each of the claim elements will not be regurgitated here. See rejection of claim 16.

Since it appears that each and every element of the Applicant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Argument #9:

Applicant Argues:

Also neither Simpson, Cronin, or MacPhail disclose a program that operates to "receive an instruction to categorize said patent application as allowed and automatically delete said unofficial documents related to the patent application" as recited in claim 16. If the Examiner disagrees, it is respectfully requested that the Examiner explicitly point what in either the Simpson, Cronin, or MacPhail reference corresponds to the recited instruction.

Examiner Responds:

Art Unit: 2169

Examiner is not persuaded. At least Simpson discloses "receiving an instruction to categorize said patent application as allowed" [Simpson: Fig. 5B; See "Notice of Allowance" indicator]. Furthermore, Rivette discloses storing a variety of types of electronic intellectual property documents [Rivette: column 10, lines 8-23]. And finally, MacPhail discloses deleting documents based on type in order to free up storage space in a computer system [MacPhail: abstract, column 1, lines 22-44 and column 1, lines 55-67 and column 2, lines 1-55].

As set forth in the preceding office action, the Examiner sets forth that the new combination of Rivette, Simpson, and MacPhail renders the Applicant's invention obvious under 35 U.S.C. 103(a). When combined, the previously mentioned combination discloses "receiv[ing] an instruction to categorize said patent application as allowed and automatically delete said unofficial documents related to the patent application."

Since it appears that each and every element of the Applicant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Argument #10:**Applicant Argues:**

For example, claim 17 recites that the claimed processor is operative with the claimed program to allow a client system to set-up "workflow rules related to defining specific types of documents to be deleted and/or specific types of documents to be saved in response to receiving an instruction that a patent application has been allowed." The Rejection states that this limitation is taught by Simpson at col. 7, lines 14-34 and by MacPhail at col. 1, lines 55-67 and col. 2, lines 1-3.

The referenced portion of Simpson discloses how docketing due dates can be tracked in a spreadsheet. There is no disclosure within that portion of Simpson, or any where else in the reference for that matter, of the claimed workflow rules. Similarly, the referenced portions of MacPhail discloses that document retention and deletion strategies are desirable and that decisions to keep or delete a document may be more complicated than the prior art systems known to the MacPhail inventors allowed for.

Art Unit: 2169

Examiner Responds:

Examiner is not persuaded. First, it is noted that the docketing system of Simpson helps govern by the "workflow" process by alerting the user as to which matters he/she should be working on. So it could be reasoned that the portion of Simpson cited above [column 7, lines 34] could be argued to be "workflow rules."

However, MacPhail more clearly sets forth "workflow rules" controlling the retention, presence, or availability of a document to a user. A rule governing the retention, presence, or availability of a document is a rule governing or affecting the workflow of the document. The document can be worked on when it is available, but it cannot be worked on after it was deleted.

Since it appears that each and every element of the Applicant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reason set forth in the preceding office action.

Argument #11:

Applicant Argues:

Accordingly, Applicants respectfully assert that the Examiner has not established a prima facie case of obviousness for claim 19 and its dependents. Applicants also note that the Examiner has again not explained the pertinence of the various reference applied against the claim.

Examiner Responds:

Examiner is not persuaded. The Examiner maintains that the rejections made under 35 U.S.C. 103(a) are proper. The rejection under 35 U.S.C. 103(a) is proper because it is set forth according to the basic factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148

Art Unit: 2169

USPQ 459 (1966). Since the rejections made under 35 U.S.C. 103(a) are proper, a prima facie case of obviousness has been made.

Furthermore, the only argument set forth by the Applicant above is a blanket denial of the Examiner's rejection. All specific arguments set forth by the Applicant have been responded to with a specific response by the Examiner. Blanket statements of denial or disagreement are not sufficient to overcome a proper rejection. The Applicant's reply to the office action must contain a writing which distinctly and specifically points out supposed errors in the Examiner's office action. See 37 C.F.R. 1.111(b).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICK A. DARNO whose telephone number is (571)272-0788. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ali can be reached on (571) 272-4105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

Art Unit: 2169

like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner
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01-12-2009

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